Remarks

Reconsideration of this Application respectfully is requested.

Status of the Application and Claims

Claims 21-90 are pending in the application, with claims 21, 35, 49, 63 and 77 being the independent claims. Claims 1-20 previously were cancelled without prejudice to or disclaimer of the subject matter recited therein.

Summary of the Office Action

In the Official Action, claims 21-90 were rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 5,721,910 to Unger et al. ("Unger") in view of U.S. Patent No. 5,924,090 to Krellenstein ("Krellenstein").

Reconsideration and withdrawal of the rejections respectfully are requested in view of the following remarks.

Rejections under 35 U.S.C. § 103

On page 2 of the Office Action claims 21-90 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,721,910 to Unger et al. ("Unger") in view of U.S. Patent No. 5,924,090 to Krellenstein ("Krellenstein"). The rejection of claims 21-90 under 35 U.S.C. 103(a) respectfully is traversed for the reasons stated below.

<u>Claims 21, 35, 49, 63 and 77</u>

Independent claims 21, 35, 49, 63 and 77 recite features not taught or suggested by the applied references. For example, claim 21 recites (emphasis added):

> searching an input first group of documents to output a second
> group of documents;

analyzing an input third group of documents according to one or more analytical functions to output a fourth group of documents; and

selectively iterating at least one of the searching and at least one of the analyzing, wherein each iteration of the searching or the analyzing is performed using as the input one of the second group of documents, the fourth group of documents, or the output of a previous iteration;

wherein said selectively iterating includes:
performing an additional iteration of the searching using the fourth group of documents as input, to output a fifth group of documents.

In another aspect, independent claim 35 similarly recites a method comprising,

inter alia:

selectively initiating at least one iteration of the search and at least one iteration of the analysis, wherein each iteration of the search or the analysis is performed using as the input one of the second group of documents, the fourth group of documents, or the output of a previous iteration;

wherein said selectively initiating at least one iteration includes:

initiating an additional iteration of the search using the fourth group of documents as input, to output a fifth group of documents.

Claims 49, 63 and 77 recite similar features of:

selectively initiating at least one iteration of the search and at least one iteration of the analysis, wherein each iteration of the search or the analysis is performed using as the input one of the second group of documents, the fourth group of documents, or the output of a previous iteration;

wherein said selectively initiating at least one iteration includes:

initiating an additional iteration of the search using the fourth group of documents as input, to output a fifth group of documents.

The above-recited iterative search process of claims 21, 35, 49, 63 and 77 is

described in Applicants' specification at least at, for example, paragraphs [0085]-

[0090], [0096], [0097], and FIG. 6. The instant specification discloses that a goal of a

search process is to identify a group of documents which satisfy search and/or

analysis criteria. Searching a first group of documents results in a second group of

documents that satisfy the search criteria, wherein the second group of documents

includes documents that were identified during the search of the first group of

documents.

On page 3 of the Office Action, the Examiner asserts that "Unger teaches the

step of further searching one or more categories (i.e., "second group [of documents]")

to identify a subset of documents" and "the set [step] of analyzed patents and/or

technical documents (i.e., "fourth group [of documents]") may then be used to identify

trends (i.e., analyzing)" in lines 25-55 of column 6.

Applicants respectfully submit that the Examiner's has mischaracterized the

cited portions of Unger. For example, lines 35-51 of column 6 of Unger read:

> "Stage V and the *Parsed data from Stage III* feed into Stage VI. *Stage VI represents a high-level overview* of a business, scientific or technical entity or specialty and provides a method for grasping the pattern of research effort represented by a collection of patents or technical documents. *These patterns are obscure at Levels I and II, and can only be clearly observed after pursuing the methods of this invention to achieve the higher level abstraction represented by Stages III through VI.*
>
> The dashed line from Stage V to Stage I represents the fact that *the data stored in the data base, and all associated analyses of Stages II [through] VI may be used to identify patents and/or technical documents* of particular interest for a particular application. The *patent numbers* for this set of patents may then be used as *unique identifiers* to *electronically link to full text sources of patents* and display the full text and associated graphic images of the set of patents. The electronic full text sources of these patents may be on a CD-ROM, a LAN or on the Internet. Unique Identifiers may similarly be used to link to sources of full-text technical or scientific documents." (emphasis added)

Stages I-VI are depicted in FIG. 1 of Unger and defined in line 62 of column 4 through line 2 of column 5 which read:

"Stages I and II represent well known methods of dealing with collections of full-text patents and semi-organized analyses of those collections of patents *in the form of spreadsheets or small databases. Stage III through VI represent the subject of this invention whereby increasingly abstract concepts and overviews can be derived from a collection of electronically available patent abstracts, and/or technical documents,* technical indexing, and patent claims." (emphasis added)

Thus, Unger's analysis is based on stage III - VI "parsed data" and "increasingly abstract concepts and overviews" "derived from a collection of electronically available patent abstracts, and/or technical documents" and excludes Stage I and II "collections of full-text patents" documents (Unger, col. 4, ln. 62 to col. 5, ln. 2 and col. 5, ln. 35).

Claims 21, 35, 49, 63 and 77 recite selectively initiating at least one iteration of a search and at least one iteration of analysis, wherein each iteration of the search or the analysis is performed using as the input one of the second group of documents, the fourth group of documents, or the output of a previous iteration. In contrast, Unger teaches that analysis of groups of documents such as the patent and technical documents comprising Stage I is *not* performed because analysis "patterns are obscure at Levels I and II, and can only be clearly observed after pursuing the methods of this invention to achieve the higher level abstraction represented by Stages III through VI" (Unger, col. 6, lns. 39-43).

Unger thus teaches away from an iterative method including iterative searching and/or analyzing of an input group of documents in order to produce an output group of documents, as recited in claims 21, 35, 49, 63 and 77.

Moreover, as Unger teaches away from what is recited in claims 21, 35, 49, 63 and 77 of the present application, Applicants submit that Unger cannot be used to establish a prima facie case of obviousness for such feature. See, M.P.E.P. §§ 2141.02 and 2145(X)(D)(2); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986) (stating a reference should be considered as a whole, and portions arguing against or teaching away from the claims much be considered); *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 16 U.S.P.Q.2d 1933 (Fed. Cir. 1990) (stating the closest prior art should not be used because the closest prior art "would likely discourage the art worker from attempting the substitution suggested by the [inventor/patentee]."); *In re Gurley*, 27 F.3d 551, 31 U.S.P.Q.3d 1130 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, …would be led in a direction divergent from the path that was taken by the applicant."); *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997) (stating a prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention).

There is a fundamental and significant difference between an iterative method using as input "a group of documents" as disclosed in the instant specification and recited in the claims, and a method using as input "abstract concepts and overviews"

as taught by Unger. The input into Unger's analysis is based on abstractions and overviews of full text patent files and technical documents, not groups of documents per se, as recited in claims 21, 35, 49, 63 and 77.

Further, although Unger may disclose linking unique identifiers such as patent numbers from data stored in a database to full text sources of patents/text and associated graphic images of documents stored on a CD-ROM, a LAN or on the Internet (Unger, col. 6, lns. 49-51), nowhere does Unger teach or suggest analyzing a group of *documents* to produce another group of *documents*, as recited in claims 21, 35, 49, 63 and 77. Rather, Unger's analysis is based on stage III data parsed from documents and abstract and overview stage IV-V data stored in a database linked by unique identifiers (patent numbers) to a group of documents stored in a separate data base (e.g., CD-ROM, LAN or Internet) (Unger, col. 3, lns. 55-59, col. 6, lns. 25-55, FIG. 1). In Unger's system, the unique identifiers (patent numbers) are not a search or analysis criteria applied to a group of documents, but are merely used to electronically link parsed data and abstractions of data (Stages III-VI) to patent and technical documents (Stage I) (Unger, col. 6, lns. 25-55 and FIG. 1). Further, Unger's unique identifiers are merely data identified after parsing patent documents and are not a group of documents, as recited in claims 21, 35, 49, 63 and 77.

In summary, the inputs into Unger's analysis are "increasingly abstract concepts and overviews" "derived from a collection of ... patent abstracts" electronically linked to full text source patent files located "in a stack of paper copies or in an electronic collection on a CD-ROM, in a database, on a LAN or on the Internet" (Unger, col. 4, ln. 62 - col. 5, ln. 2 and col. 5, lns. 3-16). In contrast, claims

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21, 35, 49, 63 and 77 recite selectively performing iterative analysis on a group of

documents resulting from a prior search or analysis iteration, to produce a group of

documents.

The Examiner concedes that Unger does not teach selectively performing an

additional iteration of the searching using the fourth group of documents as input, to

output a fifth group of documents, as recited in claims 21 35, 49, 63 and 77 (see pages

3 and 4 of the Office Action). Krellenstein is cited for allegedly teaching this feature.

Applicants submit that Krellenstein fails to remedy this deficiency of Unger.

Specifically, Applicants submit that Krellenstein fails to disclose or suggest at least

the above-discussed features of claims 21 35, 49, 63 and 77 relating to performing an

iteration of analyzing a group of documents as input, to output a group of documents.

Although Krellenstein may disclose that in order "to narrow the *search*, the user can

provide an additional *search* term (i.e., a refine instruction)" and that "upon receiving

the additional [search] term, the *search* processor 12 *searches the database* 26 and

generates another search result list corresponding to a refined set of the records"

(emphasis added) (Krellenstein, col. 5, lns. 34-38 and FIG. 2), Krellenstein lacks any

teaching or suggestion of performing an iterative method of analysis using a group of

documents as input, in order to output another group of documents, as recited in

claims 21 35, 49, 63 and 77. Rather, Krellenstein is limited to refining search result

lists by executing successive searches on a previous search result list to produce a

refined set of the records. Krellenstein clearly does not selectively iterate at least one

searching and at least one of analyzing of a group of documents, wherein each

iteration of the searching or the analyzing is performed using as the input one of a

second group of documents resulting from a previous search, a group of documents resulting from a prior analysis, or the output of a previous iteration, as recited in claims 21 35, 49, 63 and 77. While Krellenstein may disclose that "the user can (effectively) *refine the search* simply by successively opening up *additional search result categories*" (Krellenstein, col. 5, lns. 39-41) (emphasis added), Krellenstein does not disclose, teach, or suggest selectively iterating an analysis of a group of documents according to one or more analytical functions to output a group of documents, as recited in claims 21 35, 49, 63 and 77.

Thus, the allegedly obvious combination of Unger and Krellenstein does not teach or suggest each and every limitation of claims 21 35, 49, 63 and 77. Krellenstein fails to add anything to Unger that would have made obvious the claimed invention.

For at least these reasons, independent claims 21 35, 49, 63 and 77 are allowable over the applied references. Reconsideration and allowance of claims 21 35, 49, 63 and 77 is respectfully requested.

Claims 22-34, 36-48, 50-62, 64-76 and 78-90 depend from claims 21, 35, 49, 63 and 77, respectively, and are believed allowable for the same reasons. See, *In Re Fine*, 837 F.2d 1071 (Fed. Cir. 1988), and M.P.E.P. § 2143.03. Moreover, each of these dependent claims 22-34, 36-48, 50-62, 64-76 and 78-90 recites additional features in combination with the features of its respective base claim and is believed allowable in its own right. Individual consideration of the dependent claims respectfully is requested.

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Conclusion

Applicants believe that the present reply is responsive to each of the points raised by the Examiner in the official action, and submit that the application is in condition for allowance. Favorable consideration of the claims and passage to issue of the application at the Examiner's earliest convenience earnestly are solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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